

REMARKS

Reconsideration of this application, as amended, is respectfully requested. The Applicants wish to draw the Examiner's attention to the applicants' related co-pending applications and issued patents (see Appendix A) directed to nanoparticles and methods of preparation and use thereof. Office actions have already issued on many of the listed cases.

The Applicants note that the Examiner did not return the executed PTO 1449 form for the 6th Supp. IDS that was hand-delivered on September 9, 2002. Subsequent to the issuance of this Office action, the Applicants had filed a 7th Supp. IDS. Attached copies of PTO stamped post-cards show that the Patent Office did receive both IDSs, PTO-1449 forms and cited references. The Applicants request that the Examiner fully execute the PTO 1449 forms for the 6th and 7th Supp. IDSs and return a copy of the executed PTO 1449 forms to the undersigned representative. Copies of the 6th and 7th Supplemental IDSs and associated PTO 1449 forms are attached. The Examiner is requested to contact the undersigned representative if the Examiner would like to have another copy of the references.

Figures 1-4, 10, 11, and 16 (a)-(c) have been amended to include sequence identifiers as requested by the Examiner. Sequences with less than 10 nucleotides were not labeled with a sequence identifier. Under 37 C.F.R. 1.821(a), nucleotide sequences that require identification by a unique sequence identifier (SEQ ID NO:) must consist of 10 or more nucleotides. No new matter has been added to the application as a result of this amendment.

Claims 237-265 and 433-441 remain pending in this application. Turning to the Office action, the Examiner has rejected claims 237, 241-243, 251-253, 264, and 265 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over in view of the Applicants' patent U.S. Patent No. 6,417,340 (claims 1, 3, and 4); U.S. published application no. US-2003-0044805, published March 6, 2003 (U.S. serial no. 09/981,344; Our Case No. 00-713-i22) (claims 219 and 227-265); U.S. published application no. US-2002-0172953, published November 21, 2002 (U.S. serial no. 09/927,777; Our Case No. 00-653-A) (claims 219 and 227-265); U.S. published application no. US-2002-0164605, published November 7, 2002 (U.S. serial no. 09/966,312; Our Case No. 00-713-i5) (claims 237-265); U.S. published application US-2003-0059777, published March 27, 2003 (U.S. serial no. 09/957,313; Our Case No. 00-713-i3) (claims 237-265); U.S. published application US-2002-016381,

published October 31, 2002 (U.S. serial no. 09/975,498; Our Case No. 00-713-i14) (claims 237-265); US-2002-0155462, published October 24, 2002 (U.S. serial no. 09/976,577; Our Case No. 00-713-i20) (claims 237-265); US-2002-0155461, published October 24, 2002 (U.S. serial no. 09/976,378; Our Case No. 00-713-i25) (claims 237-265); US-2002-0155459, published October 24, 2002 (U.S. serial no. 09/975,062; Our Case No. 00-713-i11) (claims 237-265); US-2002-0155458, published October 24, 2002 (U.S. serial no. 09/967,409; Our Case No. 00-713-i6) (claims 237-265); US-2002-0155442, published October 24, 2002 (U.S. serial no. 09/760,500; Our Case No. 00-715-A) (claims 237-265); US-2002-0146720, published October 10, 2002 (U.S. serial no. 09/961,949; Our Case No. 00-713-i1) (claims 237-265); US-2002-0137072, published September 26, 2002 (U.S. serial no. 09/976,617; Our Case No. 00-713-i24) (claims 237-265); US-2002-0137071, published September 26, 2002 (U.S. serial no. 09/974,007; Our Case No. 00-713-i8) (claims 237-265); US-2002-0137070, published September 26, 2002 (U.S. serial no. 09/973,638; Our Case No. 00-713-i9) (claims 237-265); US-2002-0137058, published September 26, 2002 (U.S. serial no. 09/923,625; Our Case No. 00-713-B1) (claims 237-265); and US-2002-0127574, published September 12, 2002 (U.S. serial no. 09/973,788; Our Case No. 00-713-i10) (claims 237-265).

Attached please find one terminal disclaimer to obviate the rejection with respect to U.S. Patent no. 6,417,340 and a second terminal disclaimer to obviate the rejection with respect to pending applications US-2002-016381; US-2002-55462; US-2002-0155461; US-2002-0155459; US-2002-0137072; US-2002-0137071; US-2002-0137070; and US-2002-0127574. With respect to the terminal disclaimer, the following cases were not listed for at least the reason that the cited claims have been cancelled: US-2003-0044805; US-2002-0172953; US-2002-0164605; US-2003-0059777; US-2002-0155458; US-2002-0155442; US-2002-0146720; and US-2002-0137058. In view of the terminal disclaimers, the Applicants submit that withdrawal of the obviousness-type double patenting rejection is in order and is respectfully requested.

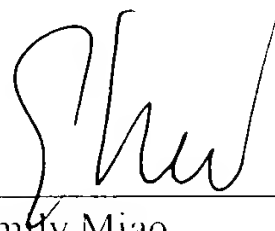
In conclusion, the Applicants respectfully submit that the claims in this application are in allowable condition and request a Notice to this effect.

Reconsideration of this application is respectfully requested and a favorable determination is earnestly solicited. The Examiner is invited to contact the undersigned

representative if the Examiner believes that this would be helpful in expediting the prosecution of this application.

Dated: 11/6/03

Respectfully submitted,



Emily Miao
Reg. No. 35,285

McDonnell Boehnen
Hulbert & Berghoff, Ltd.
300 South Wacker Drive
Chicago, IL 60606
Telephone: 312-913-0001
Facsimile: 312-913-0001

APPENDIX A

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
00-653-A	U.S. 09/927,777 Filed 8/10/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garamella, Li, Park/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	PENDING
00-713-B1	09/923,625 Filed 8/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFOR	PENDING
00-713-C	09/344,667, filed 6/25/99	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFORE	U.S. Patent No. 6,361,944, issued 3/26/02
00-713-I	U.S.S.N 09/603,830 Filed 6/26/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFOR	U.S. Patent No. 6,506,564, issued 1/14/03
00-713-I-1	09/961,949 9/20/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton;	U.S. Patent No. 6,582,921, issued June 24, 2003

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERE TO AND USES THEREFOR	
00-713-I-2	09/957,318 9/20/01	See 00-713-I-1	PENDING
00-713-I-3	09/957,313 9/20/01	See 00-713-I-1	U.S. Patent No. 6,645,721, issued 11/11/03
00-713-I-4	09/966,491 9/28/01	See 00-713-I-1	U.S. Patent No. 6,610,491
00-713-I-5	09/966,312 9/28/01	See 00-713-I-1	ALLOWED
00-713-I-6	09/967,409 9/28/01	See 00-713-I-1	PENDING
00-713-I-7	09/974,500 10/10/01	See 00-713-I-1	ALLOWED
00-713-I-8	09/974,007 10/10/01	See 00-713-I-1	PENDING
00-713-I-9	09/973,638 10/10/01	See 00-713-I-1	PENDING
00-713-I-10	09/973,788 10/10/01	See 00-713-I-1	ALLOWED
00-713-I-11	09/975,062 10/11/01	See 00-713-I-1	ALLOWED
00-713-I-12	09/975,376 10/11/01	See 00-713-I-1	PENDING
00-713-I-13	09/975,384 10/11/01	See 00-713-I-1	PENDING
00-713-I-	09/975,498	See 00-713-I-1	ALLOWED

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
14	10/11/01		
00-713-I- 15	09/975,059 11/11/01	See 00-713-I-1	PENDING
00-713-I- 16	09/976,601 10/12/01	See 00-713-I-1	PENDING
00-713-I- 17	09/976,968 10/12/01	See 00-713-I-1	PENDING
00-713-I- 18	09/976,971 10/12/01	See 00-713-I-1	ALLOWED
00-713-I- 19	09/976,863 10/12/01	See 00-713-I-1	PENDING
00-713-I- 20	09/976,577 10/12/01	See 00-713-I-1	ALLOWED
00-713-I- 21	09/976,618 10/12/01	See 00-713-I-1	PENDING
00-713-I- 22	09/981,344 10/15/01	See 00-713-I-1	PENDING
00-713-I- 23	09/976,900 10/12/01	See 00-713-I-1	PENDING
00-713-I- 24	09/976,617 10/12/01	See 00-713-I-1	PENDING
00-713-I- 25	09/976,378 10/12/01	See 00-713-I-1	PENDING
00-713-i- 26	10/410,324 04/10/03	See 00-713-I-1	PENDING
00-713-L	U.S.S.N. 09/693,005 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED	U.S. Patent No. 6,495,324, issued 12/17/02

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		THERETO AND USES THEREFORE	
00-713-M	U.S.S.N. 09/693,352 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,417,340, issued 7/9/02
00-714-G	U.S. 09/830,620 Filed 8/15/01	Mirkin, Nguyen/ NANOPARTICLES WITH POLYMER SHELLS	PENDING
00-715-A	U.S. 09/760,500 Filed 1/12/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	ALLOWED
00-1085-A	U.S.S.N. 09/820,279 Filed 3/28/01	Mirkin, Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	ALLOWED
00-1086-A	U.S. 09/903,461 Filed 7/11/01	Letsinger, Garimella/ METHOD OF DETECTION BY ENHANCEMENT OF SILVER STAINING	U.S. Patent No. 6,602,669, Filed 8/5/03
01-565-A	USSN 10/125,194 Filed 4/18/02	Mirkin, Nguyen, Watson, Park/ OLIGONUCLEOTI DE-MODIFIED ROMP POLYMERS	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		AND CO- POLYMERS	
01-599-A	U.S.S.N. 10/291,291 Filed 11/08/02	Storhoff/NOVEL THIOL-BASED METHOD FOR ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES	PENDING
01-661-A	U.S.S.N. 10/034,451 Filed 12/28/01	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-661-C	U.S.S.N. 10/153,483 Filed 5/22/02	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-661-E	U.S.S.N. 10/397,579 3/26/03	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-1565-A	U.S.S.N. 10/266,983 Filed 10/08/02	Park, Taton, Mirkin/ARRAY- BASED ELECTRICAL DETECTION OF DNA USING NANOPARTICLE PROBES	PENDING
01-1705-A	U.S.S.N. 10/108,211 Filed 3/27/02	Nam, Park, Mirkin/BIO- BARCODES BASED ON OLIGONUCLEOTI DE-MODIFIED NANOPARTICLES	PENDING
02-338-B	USSN 10/172,428 Filed 6/14/02	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	
02-338-C	10/431,341 5/7/03	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING